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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 4534

WADA et al.

Art Unit: 1731

Serial Number: 10/787,408

Examiner: Griffin, Steven P.

Filed: February 27, 2004

Docket No.: 103203-00010

For: ELECTRIC FURNACE EXTENSION METHOD AND EXTENSION  
APPARATUS FOR OPTICAL FIBER GLASS PREFORM

**RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT**  
**UNDER 37 C.F.R. § 1.121**

MAIL STOP AMENDMENT

Director of the U.S. PTO

P.O. Box 1450

Alexandria, Virginia 22313-1450

Date: May 26, 2005

Sir:

This paper is in reply to the Notice of Non-Compliant Amendment dated May 19, 2005, which indicated the claims in the above-identified Divisional Application were not provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.

Applicants respectfully submit the Notice of Non-Compliant Amendment is improper and erroneously issued.

First, Applicants respectfully note the Preliminary Amendment dated February 27, 2004 and filed concurrently with the above-identified Divisional Application, merely contained amendments to the Specification and did not in any way amend the claims filed with the application.

Second, the above-identified Divisional Application was filed under 37 CFR 1.53(b).

Third, pursuant to 37 C.F.R. § 1.121, Applicants also respectfully point out that a complete claim listing is only required whenever changes are made to any claims. The above-identified Divisional Application contains three (3) claims, which correspond to Claims 7-9 of the parent application (U.S. Application No. 09/778,107, filed February 7, 2001).

Fourth, as stated in the ***Pre-Grant Publication Helpful Hint – OG*** dated 09 October 2001, (a copy attached hereto for the convenience of the Office), “. . . [i]n order to have a patent application publication of a . . . divisional application contain only a desired set of claims, rather than the set of claims in the prior application, it is strongly recommended that the . . . divisional application be filed under 37 CFR 1.53(b) with a new specification containing only the desired set of claims.” (emphasis added herein).

Applicants respectfully submit the above-identified Divisional Application was properly filed with a new specification and only the desired claims, which were filed as Claims 1-3, correspond to Claims 7-9 of the parent application, and contain no new matter therein.

For the convenience of the Office, copies of the Notice of Non-Compliant Amendment and the February 27, 2004 Preliminary Amendment are attached hereto.

In view of the above, Applicants respectfully request withdrawal of the Notice of Non-Compliant Amendment dated May 19, 2005, entry of the February 27, 2004 Preliminary Amendment, and consideration of the application on the merits thereof.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. **103203-00010**.

Respectfully submitted,

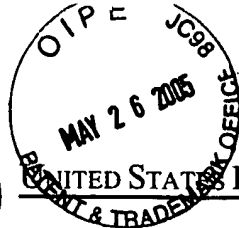
  
Murat Ozgu  
Attorney for Applicants  
Registration No. 44, 275

Enclosures: Notice of Non-Compliant Amendment  
Preliminary Amendment  
Pre-Grant Publication Helpful Hint – OG (October 9, 2001)

**Customer No. 004372**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,408	02/27/2004	Tetsuro Wada	103203-00010	4534

4372 7590 05/19/2005

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WASHINGTON, DC 20036

EXAMINER

GRIFFIN, STEVEN P

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

10 / 787 408

MAY 26 2005  
PATENT & TRADEMARK OFFICE

COMMISSIONER FOR PATENT  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. BOX 14  
ALEXANDRIA, VA 22313-14  
www.uspto.gov

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 2-27-04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required. Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted. 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
  - ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_
- ☐ 2. Abstract:
  - ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_
- ☐ 3. Amendments to the drawings: \_\_\_\_\_
- ☐ 4. Amendments to the claims:
  - ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following 7 status identifiers: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New) and (Not entered).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☐ E. Other need to be on a separate sheet.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

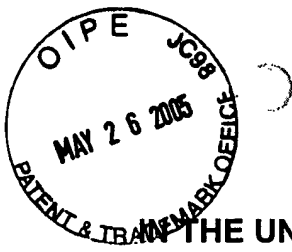
If the non-compliant amendment is a **PRELIMINARY AMENDMENT**, applicant is given **ONE MONTH** from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and this **ONE MONTH** time limit is not extendable.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION** (including a submission for an RCE), and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a **TIME PERIOD** of **ONE MONTH** from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION**, this form may be an attachment to an Advisory Action. The period for response to a final rejection continues to run from the date set in the final rejection, and is not affected by the non-compliant status of the amendment.

LAN DONG MA  
Legal Instruments Examiner (LIE)

571-272-1003  
Telephone No.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: To Be Assigned

WADA et al.

Art Unit: To Be Assigned

Serial Number: To Be Assigned

Examiner: To Be Assigned

Filed: Herewith

Docket No.: 103203-00010

For: ELECTRIC FURNACE EXTENSION METHOD AND EXTENSION  
APPARATUS FOR OPTICAL FIBER GLASS PREFORM

**PRELIMINARY AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Date: February 27, 2004

Sir:

Prior to initial examination of the above-identified patent application, please  
amend the above-identified application as follows:

**IN THE SPECIFICATION:**

On page 21, please insert the following paragraph between lines 1 and 2:

--Fig. 10 is a graph illustrating the temperature, extension rate, and extension speed of a glass body from an initial state to a steady state;--

On page 21, please amend the paragraph beginning at line 2 as follows:

Fig. ~~40~~ 11 is a view of a state of deformation of the glass body before the start of drawing; and

On page 21, please amend the paragraph beginning at line 4 as follows:

Fig. ~~44~~ 12 is a view of the shape of the extended portion of the glass body when an extended meniscus shape is formed after the start of the extending.

On page 39, please amend the paragraph beginning at line 22 as follows:

Figure ~~40~~ 11 shows the shape of the glass body in the initial stage of drawing in which the meniscus has not yet been formed.

On page 39, please amend the paragraph beginning at line 25 through line 2 on page 40 as follows:

Figure ~~44~~ 12 shows the state where the drawn meniscus is formed after an elapse of a predetermined time and the shape of the glass body changes.

On page 40, please amend the paragraph beginning at line 3 as follows:

In Fig. ~~11~~ 12, the first portion 21A for measurement of the outer diameter of the extended portion 21 of the optical fiber glass body 20 is located at the position where the meniscus angle  $\theta$  at the extended meniscus 21a is  $4^\circ$  or less.



**REMARKS**

This is a divisional of Application Serial No. 09/778,107, filed February 7, 2001, which is a divisional of Application No. 09/047,373, filed March 25, 1998, now U.S. Patent No. 6,279,353.

Claims 1-3 are pending.

The amendments to the specification are made to correct the omission of Figure 12 from the brief description of the drawings section and related portions in the detailed description section. The amendments were also made in the '107 patent application to correct the same informalities therein.

Favorable consideration on the merits is respectfully requested.

Should any additional fees be due with respect to this paper, such fees may be charged to Counsel's Deposit Account No. 01-2300, referencing Docket No. 103203-00010.

Respectfully submitted,

**ARENT FOX PLLC**



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Reg. No. 44,275

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Pre-Grant Publication Helpful Hint:  
File Continuation or Divisional Application with a  
New Specification and Copy of Oath or  
Declaration from Prior Application

If a continuing application is being filed that has any differences in the specification (including claims) relative to the prior application, the guidelines in this notice should be followed to ensure that the desired information gets published. Any utility or plant patent application, including any continuing application, that will be published pursuant to 35 U.S.C. 122(b) should be filed under 37 CFR 1.53(b) with a specification (including the claims), and drawings, that applicant would like to have published. This is important because the Office will generally publish the specification (including the claims) and drawings as filed and, under 35 U.S.C. 154(d), a patentee may obtain provisional rights if the invention claimed in a patent is substantially identical to the invention claimed in the application publication. Filing a continuing application under 37 CFR 1.53(b) with a preliminary amendment (which makes all the desired changes to the specification, including adding, deleting or amending claims) is NOT recommended because the changes made by the preliminary amendment will generally not be reflected in the patent application publication even if the preliminary amendment is referred to in an oath or declaration.

A continuation or divisional application filed under 37 CFR 1.53(b) may be filed with a new specification and corrected drawings, along with a copy of an oath or declaration from a prior (parent) application, so long as no matter is included in the new specification and corrected drawings that would have been new matter in the prior application. Thus, the new specification and corrected drawings may include some or all of the amendments entered during the prosecution of the prior application(s), as well as additional amendments submitted for clarity or contextual purposes, and a new set of claims. See Changes to Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53132, 53148 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63, 77 (October 21, 1997), and 37 CFR 1.63(d)(1).

In order to have a patent application publication of a continuation or divisional application contain only a desired set of claims, rather than the set of claims in the prior application, it is strongly recommended that the continuation or divisional application be filed under 37 CFR 1.53(b) with a new specification containing only the desired set of claims. If the continuation or divisional application is filed with a copy of the specification from the prior application along with a preliminary amendment which cancels, amends and/or adds new claims, publication of the application, as amended, would only occur if a copy of the specification (with the amended set of claims) was also submitted through the Office's Electronic Filing System (EFS). See 37 CFR 1.215(a) and (c), and Assignment of Confirmation Number and Time Period for Filing a Copy of an Application by EFS for Eighteen-Month Publication Purposes, 1241 Off. Gaz. Pat. Office 97 (December 26, 2000).

General questions regarding publication of patent applications should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 305-8283. Questions regarding EFS should be directed to the Electronic Business Center Help desk at (703) 305-3028. Questions regarding filing applications under 37 CFR 1.53(b) should be directed to Eugenia Jones or Fred Silverberg, Senior Legal Advisors in the Office of Patent Legal Administration. Ms. Jones can be

reached by telephone at (703)306-5586 and by e-mail at  
Eugenia.Jones@uspto.gov. Mr. Silverberg can be reached by telephone at  
(703)305-8986 and by e-mail at Fred.Silverberg@uspto.gov.

September 12, 2001

STEPHEN G. KUNIN  
Deputy Commissioner for  
Patent Examination Policy